

Mailed: 2/24/03

This Opinion is Not  
Citable as Precedent of  
the TTAB

Paper No. 19  
GFR

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Sit 'n Sleep, Inc.  
v.  
Harrco Industries, Inc.

Opposition No. 91121589  
to application Serial No. 75/851,438  
filed on November 15, 1999

Sit 'n Sleep, Inc., pro se.

Richard A. Joel of Joel & Joel, LLP for Harrco  
Industries, Inc.

Before Simms, Rogers and Drost,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant Harrco Industries, Inc. seeks to register the mark SIT-N-SLEEP COVERS for goods identified as "bed covers." The application is based on applicant's stated intention to use the mark in commerce, and includes a disclaimer of exclusive rights in the term COVERS. Though the application was never amended to assert use of

the mark in commerce, it is clear from the record that applicant is using its mark.

The application has been opposed by Sit 'n Sleep, Inc., appearing herein pro se. By its president, James R. Carter, opposer alleges the following in its notice of opposition:

"'Sit 'n Sleep' is a live registered service mark, registration #1,594,658" owned by opposer and is registered "for goods and services in home furnishings"; applicant's application is "for goods and services in home furnishings"; opposer "has established a reputation of high quality"; there "is no affiliation between" opposer and applicant; "use of the mark 'Sit 'n Sleep' with the word 'covers' creates a likelihood of confusion" and that the "combination implies that Sit 'n Sleep, Inc. is the source of origin for the covers"; "[i]t is unfair to grant trademark protection to those combining an existing mark with other words unless it is being granted to the original holder of that existing mark"; applicant, because its application includes a disclaimer of "covers" is "making claim to 'Sit 'n Sleep'"; opposer "wants the flexibility of being able to privately label upholstered furniture and futon covers with its mark 'Sit 'n Sleep'."

In addition, opposer alleges that "Harrco Industries has been operating a website on the internet ([www.sitnsleepcovers.com](http://www.sitnsleepcovers.com)). On that site 'Sit-n-Sleep-Covers' is displayed with the '®'. This practice is not allowed by U.S. Patents and Trade Mark Office [sic]. Printed copies of that web site are enclosed."

Applicant, in its answer, admits that its application includes a disclaimer of COVERS and that SIT-N-SLEEP "is part of its trademark for decorative bed covers." It also admits that "it has been operating a website on the internet and that SIT-N-SLEEP COVERS are featured on the website." Otherwise, applicant has expressly or effectively denied the allegations of the notice of opposition. For affirmative defenses, applicant asserts that it is entitled to a registration for its mark in International Class 24 for decorative bed covers "which is distinct from the retail store services covered by plaintiff's composite registration for sit 'n sleep® and design (an oval surrounding small letters with a very distinctive owl)"; that applicant uses its mark only on decorative bed covers; that there is no likelihood of confusion because of differences in the marks and channels of trade; that "opposer is guilty of laches since defendant has being [sic] using [sic] mark

since November 15, 1999 in interstate commerce"; that opposer has acquiesced in applicant's use of its mark "by permitting the unquestioned use" of the mark "for several years"; and that opposer "is guilty of unclean hands in alleging injury where there is conspicuously none."

We view the notice of opposition as setting forth two claims. First, it sets forth a claim under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d). Second, it sets forth a claim that applicant has misused the statutory registration symbol. In regard to applicant's answer, we take certain statements in applicant's listing of "affirmative defenses" as mere amplification of its denial that there is a likelihood of confusion among consumers. We give no consideration to the asserted defenses of laches, acquiescence and unclean hands, as applicant has neither presented any evidence in support of these defenses nor even discussed them in its brief.<sup>1</sup>

After pleading, the parties apparently exchanged written discovery requests, as they filed cross-motions

---

<sup>1</sup> Moreover, it is well settled that, in an opposition, the time for measuring laches does not run from the date of an applicant's first use but, rather, only from the date of publication of the mark for opposition. See National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1576, 19 USPQ2d 1424, 1427 (Fed. Cir. 1991).

to compel. Though the Board denied these motions, each party obtained discovery responses from the other, as each has introduced responses into the record (see the discussion, below, regarding creation of the record).

Neither opposer nor applicant took any testimony or filed any notices of reliance. Applicant did not file a motion to dismiss after opposer's main testimony period closed. Each party has filed a main brief with various attachments. Opposer refers to its submission as a brief with exhibits; applicant refers to its submission as "testimony and brief." Opposer's "rebuttal" submission includes both additional briefing and additional exhibits. After briefing was completed, each of the parties submitted supplemental correspondence and exhibits.

Neither party has objected to any of the exhibits or submissions of the other. Accordingly, we consider the various exhibits submitted with the parties' respective briefs as if they have been stipulated into the record.<sup>2</sup>

---

<sup>2</sup> We do not, however, consider applicant to have stipulated to entry into the record of the exhibits attached to the notice of opposition. It is well settled that material submitted with a Board plaintiff's pleading, except for an Office-certified copy of a pleaded registration, is not considered part of the record. See authorities collected in TBMP § 313. Applicant has, with a noted few exceptions, denied the allegations of the notice of opposition and left opposer to its proofs. Thus, we do not consider applicant to have admitted the authenticity or

Racine Industries Inc. v. Bane-Clene Corp., 35 USPQ2d 1832, 1834 n.4 (TTAB 1995) (Letters "not proper subject matter for a notice of reliance... deemed to have been stipulated into the record" when adverse party treated them as part of record), and JSB International, Inc. v. Auto Sound North, Inc., 215 USPQ 60 n.3 (TTAB 1982) (By notice of reliance, each party filed, without objection by the other, materials produced in response to requests for production; and Board stated it would "treat them as having been stipulated into the record.")

Notwithstanding their unqualified admission into the record, we have considered the probative value of the submissions on their merits, in conjunction with our weighing of evidence that bears on the various *du Pont*<sup>3</sup> factors.

---

probative value of any of the exhibits attached to opposer's notice of opposition. Cf. Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991)(defendant held to have admitted only issuance of plaintiff's pleaded registrations, not status and title, and express or effective denials of allegations put plaintiff on notice that it would have to prove its case).

Also, we have not considered the exhibits submitted with the supplemental correspondence each party filed after briefing was completed. Applicant objected to opposer's first of two such submissions and we agree that it is inappropriate for either party to have submitted additional evidence or arguments after briefing, notwithstanding our decision to treat the submission of evidence with briefs as pursuant to stipulation.

<sup>3</sup> In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (enumerating factors that may be considered

Applicant has admitted that opposer's pleaded registration issued and that it is owned by opposer. (Answer paragraphs 1 & 2, brief p. 1 & exhibit 1)

Opposer has introduced a reprint from the Office's TARR database showing that its registration was renewed July 15, 2000 and that, as of the February 3, 2002 date of the printout, the "current status" of the registration is "renewed." In essence, the parties have treated opposer's registration as if it is of record. See Floralife, Inc. v. Floraline International Inc., 225 USPQ 683 (TTAB 1984), affirmed in unpublished opinion, 790 F.2d 94 (Fed. Cir. 1986).

Because opposer is the owner of a valid registration, priority is not an issue in this case. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

We turn, then, to the question of likelihood of confusion. In any case involving this question, two key considerations are the similarities of the involved marks and the relatedness of the goods or services. Federated

---

in evaluating likelihood of confusion, when relevant evidence is of record).

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

As already noted, applicant's mark is SIT-N-SLEEP COVERS. Opposer's registered mark is set forth below:



Each of the involved marks includes the words "sit" and "sleep" and the letter "n" used in the manner of a connector or as a shorthand reference to the word "and." Thus, the literal element of opposer's mark and the non-disclaimed portion of applicant's mark are the same.<sup>4</sup> The fact that opposer's mark uses an apostrophe before the letter "n" and applicant's mark utilizes hyphens to connect SIT, N and SLEEP is of no significance in terms of the sound or connotation of opposer's mark and applicant's use of SIT-N-SLEEP in its mark.

Plainly, the literal element of opposer's mark and the non-generic portion of applicant's mark would be

---

<sup>4</sup> While even disclaimed matter must be considered in a likelihood of confusion analysis, COVERS is clearly a generic term for goods identified as "bed covers" and would not be relied on by the public to distinguish applicant's goods from other goods or related services. In re National Data Corporation, 224 USPQ 749, 752 (Fed. Cir. 1985). Thus, this component of applicant's mark is given less weight in our assessment of the likelihood of confusion.



pronounced the same. In terms of appearance, the inclusion of an owl in opposer's mark and the word COVERS in applicant's mark will contribute to a visual difference between the marks, even if applicant uses the same typeface as that used for the words in opposer's mark.<sup>5</sup> In terms of connotation, we find that the marks would be perceived as having similar connotations. Applicant contends that opposer's retail store will essentially be referred to as the "owl furniture store." We find to the contrary. If both words and a design comprise a mark, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by them to request the goods and/or services. In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987); and Kabushiki Kaisha Hattori Tokeiten v. Scutotto, 228 USPQ 461, 462 (TTAB 1985). See also: Giant Food, Inc. v. Nation's Food Service, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In addition, opposer's trade name is Sit 'N Sleep, Inc., and it has a

---

<sup>5</sup> When an applicant applies to register a mark in typed form, we must consider the possibility that the mark could be presented in any reasonable form of display. INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992). In this case, that means we must consider the possibility of applicant presenting its mark in the same typeface as the literal elements of opposer's mark.

web site with an address of <http://sitnsleepga.com>. The use of the trade name and web site address will reinforce the connotation of the mark as being derived principally from its literal element.<sup>6</sup>

In sum, we find the similarity of the marks in pronunciation and connotation to outweigh the visual difference that stems from opposer's inclusion of an owl design in its mark and applicant's inclusion of the generic word COVERS in its mark.

Turning to the goods and services, their channels of trade, and classes of consumers, applicant stresses that opposer operates a retail store under its mark<sup>7</sup>, while applicant uses its mark for a single product and that product is available for purchase "strictly" over the internet. (Brief p. 3) The limited record, however, is contradictory in terms of the nature of applicant's business. Among applicant's responses to opposer's interrogatories are statements that it is only a distributor of bed covers and its web site is "not a

---

<sup>6</sup> As opposer notes in its rebuttal brief, "Nobody draws an owl on the checks they write the plaintiff. No vendor has ever invoiced the plaintiff with an owl in the name and address. No radio ad has ever used the owl with the name." (Rebuttal brief p. 10)

<sup>7</sup> The identification in opposer's registration is for "retail furniture store services."

retail outlet." On the other hand, there are statements that sales to buyers are made via the internet and that a consumer can request a copy of applicant's catalog via the internet. Finally, opposer has made a copy of what appears to be a catalog or brochure of record (opposer's exhibit 9), which plainly invites applicant's customers to order applicant's products via a toll-free phone number.

Our analysis of the relatedness of the goods and services, their channels of trade, and classes of consumers is governed not by what the record shows but, rather, by the respective identifications in opposer's registration and applicant's application. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Indeed, the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration"); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The

authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Accordingly, since there are no restrictions as to the channels of trade or classes of consumers in applicant's identification, we must consider the goods to be sold in all customary channels of trade for bed covers and to all customary classes of consumers for bed covers. This means we must consider applicant's bed covers to be sold at wholesale to retailers and at retail to ultimate consumers; and that sales may be made by internet, telephone, mail order or via in-person purchases.

There is no per se rule that confusion is or is not likely when one party is using a mark on a product and the other is using a similar mark for services which could entail selling that product. Certainly, we would not expect opposer to create the likelihood of consumer confusion by selling applicant's product in its retail

furniture store(s).<sup>8</sup> On the other hand, we find that there is a likelihood of consumer confusion even if we discount the possibility of applicant's goods being sold in opposer's store(s). It is sufficient that the goods and services are related in some manner, or that the circumstances of marketing are such that the branded goods or services are likely to be encountered by persons who would assume some relation or that they emanate from the same source. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

In the case at hand, patrons of opposer's store(s) would be purchasing furniture, a term which, because of the unrestricted identification and by the evidence of record, is taken to include beds. When such patrons are subsequently confronted with applicant's SIT-N-SLEEP COVERS brand bed covers, they would likely consider there

---

<sup>8</sup> Applicant stresses that opposer operates a single furniture store and the extent of its use of its mark "has been restricted to a thirty five (35) mile radius of Carrolton, Georgia." (Brief pp. 2-3) There is, however, no evidence of record to support this argument and the identification in opposer's registration is not so limited. Thus, we must consider the operation of additional stores to be within the scope of the identification.

to be some connection between opposer and the source of the bed covers, as, for example, by license, sponsorship, or marketing through a related company.

Applicant argues that such a connection would not be drawn by consumers, because opposer has tolerated use of "Sit 'n Sleep" marks by various other entities. (Brief p. 2) Applicant's only support for this argument is interrogatory responses from opposer. However, applicant has not provided us with the interrogatories themselves, so we cannot give much weight to the responses. In particular, the record does not reveal what goods or services these other entities may be offering under their marks or whether they are still in business. Notwithstanding the infirmity of support for applicant's argument, even if we assume that opposer has chosen to coexist with other users of "Sit 'n Sleep" marks, this cannot aid applicant.

In its rebuttal brief, opposer argues that it is not obligated to restrain use of the mark in Germany (the apparent location of another user of "Sit 'n Sleep"), has stopped numerous other users, and is concerned with applicant, as opposed to other users of "Sit 'n Sleep" marks, because both opposer and applicant are doing business in the same manner (i.e., via the internet) and

because applicant is seeking a federal registration. (Rebuttal Brief pp. 3-4) Whether opposer, by apparent inaction with regard to certain other users of "Sit 'n Sleep" marks, may now be barred from challenging one or more such uses, is not a question before us. Applicant cannot, in this opposition, rely on purported rights of others to establish that it has the right to obtain a federal registration for a mark when there is a likelihood of confusion among consumers. See, e.g., The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc., 191 USPQ 468 (TTAB 1976) (laches and estoppel are personal defenses which may not be asserted by a third party not in privity with the party that may have the right to assert the defense).

Finally, while applicant argues that there has been no actual confusion, the parties have only been using their marks concurrently for a few years, and the record is devoid of information on the extent of applicant's sales or advertising. Thus, there is little context within which we can assess the weight to be accorded the apparent absence of instances of actual confusion.

When we consider this limited record for what it shows in relation to the *du Pont* factors, we find the balance tips in favor of opposer. Moreover, if there

were any doubt about likelihood of confusion we would, of course, resolve such doubt in favor of opposer, as the prior user and registrant. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

The opposition is sustained as to opposer's claim under Section 2(d) of the Lanham Act. On the other hand, the opposition is dismissed for failure of proof in regard to opposer's claim that applicant has misused the statutory registration symbol.

As noted in Wells Fargo & Co. v. Lundeen & Associates, 20 USPQ2d 1156, 1157 (TTAB 1991): "Improper use of the federal registration symbol by an applicant can defeat an applicant's right to registration where misuse of the symbol is occasioned by an intent to deceive the purchasing public or others in the trade into believing that the mark was registered. See e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); Knorr-Nahrmittel Akg v. Havland International, Inc., 206 USPQ 827 (TTAB 1980)." In this case, while opposer has established that applicant has misused the registration symbol, opposer has not established the intent of applicant to deceive the purchasing public.



Decision: The opposition is sustained, but only as to opposer's claim that there is a likelihood of confusion among consumers attributable to the contemporaneous use of the parties' respective marks for, on the one hand, retail furniture store services and, on the other hand, bed covers.